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/Abby Berghella/
Abby Berghella

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

Bart Alan MELTZER et al.

Application No. 09/173,858

Confirmation No. 4734

Filed: 16 October 1998

Title: **Documents for Commerce in Trading
Partner Networks and Interface
Definitions Based on the Documents**

Group Art Unit: 2178

Examiner: HUYNH, Cong Lac T.

CUSTOMER NO. 22470

Mail Stop Petition
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION UNDER THE 37 CFR 1.183 REGARDING ENTRY OF
RULE 131 DECLARATIONS BY FEWER THAN ALL INVENTORS**

Sir:

Applicants petition under 37 C.F.R. §§ 1.183 and/or 1.182 requesting waiver of the signature of an unavailable inventor and acceptance of other evidence as well. Three particular requests are presented below.

FIRST, this application has five co-inventors. Terry Allen initially signed his oath or declaration for the patent application under 37 CFR 1.63, but has been unavailable since he left the company. He has maintained very little, if any, contact with his fellow inventors. He previously refused to accept by mail a draft declaration and again unavailable to sign an affidavit or declaration under 37 CFR 1.131, because he refused our mail.

A previous set of declarations by four inventors (not including Mr. Allen) has already been considered on the merits by the Board, in this application. We improved on the process of trying to reach Mr. Allen for this round of declarations, beyond what was done for the declarations that the Board already has considered.

We searched the county's tax roll and property ownership records to get a physical address, in addition to the PO Box address that we have had on file since Mr. Allen left the company. We sent Express Mail packages to both the tax parcel address and the PO Box. Both Express Mail packages, Nos. EM 246708502 US, and EM 246708516 US, were returned to us unopened and refused, as documented in the attached declaration of legal assistant Brianna Dahlberg. The USPS form indicates that the packages were refused. Identical handwritten notes appear on both packages, "REF T.A.", which we take to mean "refused by Terry Allen".

Given that Mr. Allen has refused these packages and refused mail containing a draft declaration that we sent him a few years ago, it would be futile to have a stranger try to deliver to Mr. Allen what he handed back to the postal clerks in the small town where he lives.

WHEREFORE, pursuant to the instructions in MPEP § 715.05 at 700-281 (Rev. 6, Sept. 2007), we request that the Office of Petitions waive the signature of the unavailable inventor. Applicants have been diligent in pursuing the unavailable inventor's cooperation, have secured the cooperation of four other inventors, and have secured the cooperation of a percipient witness, who worked with the inventors.

FURTHERMORE, we have obtained a percipient witness declaration of Kevin Hughes, a non-inventor who worked with the inventors. His declaration has been submitted, in part because he had in his possession a computer program archive that has been used to corroborate declarations by the available inventors. Mr. Hughes'

declaration should be admissible under 35 USC § 102 to show that the reference cited by the Examiner was not published prior to the inventors' actual reduction to practice of their invention. *Ex parte Foster*, 105 O.G. 261 (Comm'r Pat. 1903). We consider *Ex parte Foster* to be good law, although it is 105 years old, because the MPEP § 715.04 at 700-281, continues to cite it regarding evidence from non-inventors. We are unaware of any statutory or case law authority that would prevent applicants from using proof other than what rule 131 specifies, in order to demonstrate that a reference was not published before an invention was actually reduced to practice. While rule 131 provides a safe harbor for swearing behind a reference, the rule is permissive and does not, on its face, limit the applicants to using proof from inventors.

While we think that the law is clear, the Office of Petitions is in a better position to consider the issue than an examiner who has engineering but not legal training.

WHEREFORE, we request under rule 183 or 182, as may be considered appropriate, that the Office of Petitions direct the Examiner to consider and weigh Kevin Hughes' declaration and its supporting exhibits as evidence of an actual reduction to practice, which may remove the McKendrick reference.

FURTHERMORE, we have public records of a public demonstration, at a conference, of a data structure that we contend is within the scope of the claims. The public display of the data structure was on July 25, 1998, two months before the September 1998 publication date of the McKendrick reference. Like Hughes' declaration, this evidence should be admissible under 35 USC § 102, as interpreted in *Ex parte Foster, supra*, to show that the reference was not published prior to the inventors' actual reduction to practice of their invention. In addition to the public record of what inventor Dr. Glushko displayed on July 25, 1998 (Ex. I), there is a transcript of remarks that Dr. Glushko made on September 1, 1998 and a variety of other publications in the record that the examiner has not yet considered.

WHEREFORE, we request under rule 183 or 182, as may be considered appropriate, that the Office of Petitions direct the Examiner to consider and weigh the public documents that are of record in this case, on the issue of removing McKendrick as a reference.

CONCLUSION

Counsel invites the personnel at the Office of Petitions to call and discuss this petition. The application is ten years old, so expeditious handling is respectfully requested. The undersigned can ordinarily be reached at his office at (650) 712-0340 from 8:30 a.m. to 5:30 p.m. PST, Monday through Friday, and can be reached at his cell phone at (415) 902-6112 most other times.

Respectfully submitted,

Dated: 21 July 2008

By: /Ernest J. Beffel, Jr./
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RELATED AND/OR ACCOMPANYING DOCUMENTS:

Declaration of Brianna Dahlberg re Unavailable Inventor;

Inventor's Declaration Under Rule 131 Proving Reduction to Practice on or Before January 21, 1998 (Bart Alan Meltzer);

Inventor's Declaration Under Rule 131 Proving Reduction to Practice on or Before January 21, 1998 (Matthew Fuchs);

Inventor's Declaration Under Rule 131 Proving Reduction to Practice on or Before January 21, 1998 (Murray Maloney);

Inventor's Declaration Under Rule 131 Proving Reduction to Practice on or Before January 21, 1998 (Robert John Glushko);

Non-Inventor's Declaration Under Rule 131 Proving Reduction to Practice on or Before January 21, 1998 (Kevin Hughes);

Compilation of Exhibits A-J